

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. The amendments and remarks made in this Response are appropriate under 37 C.F.R. § 116 as they respond to remarks made by the Office in the Final Action, and they place the claims in better condition for allowance, or for appeal in the event that the Office maintains its rejection.

Claims 1-6 and 22-26 are pending.

Discussion of Examiner's Remarks

In the *Response to Arguments* section of the recent Final Action (see Page 5), the Examiner broadly interprets the phrase "a form factor of a PCMCIA card" as meaning "PCMCIA compliant." Applicant disagrees with this interpretation, as the claims unambiguously specify "form factor". The term "form factor" refers to the physical size of a device as measured by outside dimensions. With regard to a disk drive, for example, the form factor is the overall diameter of the platters and case, such as 3.5" or 5.25". PCMCIA has its own specific dimensions that define its form factor. Applicant uses the term "form factor" in the claims according to this traditional and well understood meaning.

It is also noted that, for purposes of evaluating the patentability of claims, it is immaterial as to what terms are used in the application title. The subject matter to be examined is that which is defined by the express terms contained in the claims and not those contained in the title.

In any event, the Office encourages Applicant to specify the distinction between "PCMCIA-compliant" and "PCMCIA form factor". Toward this end, Applicant has amended the two independent claims to further clarify that the term

1 “form factor” refers to physical size. More specifically, claim 1 is amended to
2 recite “a device physically sized in a form factor of a PCMCIA card” and claim
3 22 is amended to recite “a smart card secured memory assembly physically sized
4 in a form factor of a PCMCIA card”.

5
6 **35 U.S.C. §102**

7 Claims 1, 2, 5, 22, and 24 are rejected under 35 U.S.C. §102 as being
8 anticipated by U.S. Patent No. 6,234,389 to Valliani et al. (hereinafter, “Valliani”).
9 Applicant respectfully traverses the rejection.

10 **Claim 1**, as amended, defines an assembly comprising “a device physically
11 sized in a form factor of a PCMCIA card, the device having an interface to
12 communicate with a storage card and memory to store user data”. The assembly
13 further comprises “a removable storage card associated with a user that alternately
14 enables access to the user data on the memory when interfaced with the device
15 interface and disables access to the user data when removed from the device.”

16 Valliani does not disclose the claimed assembly. Namely, Valliani does not
17 disclose a device (which communicates with the removable storage card) that is
18 “physically sized in a form factor of a PCMCIA card.”

19 Applicant respectfully requests that the §102 rejection of claim 1 be
20 withdrawn.

21 **Claims 2 and 5** depend from claim 1 and are allowable by virtue of this
22 dependency.

23 **Independent claim 2**, as amended, requires “a computer having a
24 PCMCIA device reader” and “a smart card secured memory assembly physically
25 sized in a form factor of a PCMCIA card to compatibly interface with the

1 PCMCIA device reader in the computer". Claim 22 further requires that the smart
2 card secured memory assembly have "data memory to store user data and a
3 removable smart card that alternately enables access to the user data when present
4 and disables access to the user data when removed."

5 Valliani is entirely silent as to the recited smart card secured memory
6 assembly. For the reasons given above with respect to claim 1, Valliani does not
7 describe an assembly "physically sized in a form factor of a PCMCIA card to
8 compatibly interface with the PCMCIA device reader in the computer". Secondly,
9 Valliani does not disclose a "removable smart card that alternately enables access
10 to the user data when present and disables access to the user data when removed."

11 Accordingly, claim 22 is patentable over Valliani. Application respectfully
12 requests withdrawal of the §102 rejection.

13 Claim 24 depends from claim 22 and is allowable by virtue of this
14 dependency.

15
16 **35 U.S.C. §103**

17 **Claims 3, 4, and 23**

18 Claims 3, 4, and 23 stand rejected under 35 U.S.C. §103 as being
19 unpatentable over Valliani in view of U.S. Patent No. 5,701,884 to Dedrick
20 (hereinafter, "Dedrick"). Applicant respectfully traverses the rejection.

21 **Claims 3 and 4** depend from claim 1 and **claim 23** depends from claim 22.
22 Hence, these claims recite the two-component assembly that is "physically sized in
23 a form factor of a PCMCIA card." Neither Valliani nor Dedrick teaches or
24 suggests this feature.
25

1 Applicant respectfully requests that the §103 rejection of claims 3, 4, and
2 23 be withdrawn.

3 Claims 6, 25, and 26

4 Claims 6, 25, and 26 stand rejected under 35 U.S.C. §103 as being
5 unpatentable over Valliani in view of U.S. Patent No. 5,623,637 to Jones et al.
6 (hereinafter, "Jones"). Applicant respectfully traverses the rejection.

7 Claim 6 depends from claim 1 and claims 25 and 26 depend from claim
8 22. Hence, these claims recite the two-component assembly that is "physically
9 sized in a form factor of a PCMCIA card." Valliani does not teach or suggest this
10 feature. Jones likewise fails in this regard. Accordingly, the combination of
11 Valliani and Jones fails to teach or suggest the features of claims 6, 25, and 26.
12 Applicant respectfully requests that the §103 rejection of these claims be
13 withdrawn.

Conclusion

All pending claims 1-6 and 22-26 are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the subject application. If any issues remain that prevent issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully submitted,

Dated: 10/23/2002By: 

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MARKED UP VERSION OF PENDING CLAIMS UNDER 37 C.F.R. 1.121(C)(1)(ii):

Kindly amend claims 1 and 22 as follows and in accordance with 37 C.F.R. § 1.121(c)(1)(ii), by which the Applicant submits the following marked up version only for claims being changed by the current amendment, wherein the markings are shown by brackets (for deleted matter) and/or underlining (for added matter):

1. (Once Amended) An assembly comprising:

a device [constructed] physically sized in a form factor of a PCMCIA card, the device having an interface to communicate with a storage card and memory to store user data; and

a removable storage card associated with a user that alternately enables access to the user data on the memory when interfaced with the device interface and disables access to the user data when removed from the device.

22. (Once Amended) A computer system, comprising:

a computer having a PCMCIA device reader; and

a smart card secured memory assembly physically sized in [having] a form factor of a PCMCIA card to compatibly interface with the PCMCIA device reader in the computer, the smart card secured memory assembly having data memory to store user data and a removable smart card that alternately enables access to the user data when present and disables access to the user data when removed.